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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/492,697	01/27/00	DUJON	B 3495.0111-11

EXAMINER	
KAUSHAL,S	
ART UNIT	PAPER NUMBER
1633	4

DATE MAILED: 06/06/00

HM12/0606
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/492,697	Dujon et al
Examiner	**Group Art Unit**
SUMESH KAUSHAL	1633

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 23-44 is/are pending in the applicat

Of the above, claim(s) 38-44 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 23-44 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Specification

1. This application does not contain Page No.1 which should include "Cross reference to related application" and subtitle "Background of the invention". Appropriate correction is required.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 23-37, drawn to a recombinant mammalian or plant chromosome and cells comprising an endonuclease site (I-SceI), classified in class 435, subclass 325.

II. Claims 38-44, drawn to a retroviral vector comprising an endonuclease site, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the recombinant chromosome and the retroviral vectors encoding I-SceI are structurally and functionally different products. For example, the retroviral vector deliver the encoded gene by infecting cells whereas delivery of an artificial chromosome requires the transfection of recombinant chromosome. Furthermore, method of making recombinant chromosome and retroviral vector are distinct. Thus, these inventions are distinct and are of separate use.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

If Group-I is elected, note that claim 24-27, 31-34 is generic to the following patentably distinct gene families. Restriction to one of the gene family as listed below is required:

a) HO endonucleases sites, b) Group-I intron encoded endonucleases sites, each of which is structurally different in terms of the nucleotide sequences and how it cleaved by restriction endonucleases.

During a telephone conversation with Salvatore Arrigo on 5/22/00 a provisional election was made **without traverse** to prosecute the invention of **Group-I, claims 22-37** with further election of group **b)** *Group-I endonucleases*, with further election of *Class I I-endonucleases* wherein the elected Class I I-endonucleas is ***I-SceI endonuclease***. Affirmation of this election must be made by applicant in replying to this Office action. Claims 38-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim 1 is generic and reads on a recombinant mammalian or plant chromosome comprising an endonuclease site selected from the group consisting of HO and Group-I intron encoded endonucleases sites. The claimed invention will be examined only to the extent that it reads on the elected invention. The claims must be amended according to the election herein since the claims as presently drafted contain non-elected subject matter which has been withdrawn from consideration. The claims as currently drafted if free of rejections could not be indicated as allowable until the non-elected subject matter is removed from the generic claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 23-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,948,678. Although the conflicting claims are not identical, they are not patentably distinct from each other because US Pat. No. '678 claims a recombinant animal or plant chromosome and cells comprising a nucleotide sequence encoding I-SceI which encompass the recombinant mammalian or plant chromosomes and cells encoding I-Sce-I site. Thus, the instant invention is obvious in view of US Pat. No. 5948678.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor John L. LeGuyader can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned as (703) 308-2035. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

S. Kaushal, AU 1633

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